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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/692,402	10/19/2000	William X. Tracy	467X-1CA	6085

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EXAMINER	
DIXON, THOMAS A	
ART UNIT	PAPER NUMBER

3629

DATE MAILED: 09/05/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	09/692,402	TRACY ET AL.
	<b>Examiner</b>	<b>Art Unit</b>
	Thomas A. Dixon	3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### **Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on 09 April 2002.

2a)  This action is **FINAL**.                            2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

4)  Claim(s) 23-30 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 23-29 is/are rejected.

7)  Claim(s) 30 is/are objected to.

8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)  The proposed drawing correction filed on \_\_\_\_\_ is: a)  approved b)  disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)  The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

13)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)  All b)  Some \* c)  None of:

1.  Certified copies of the priority documents have been received.
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14)  Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a)  The translation of the foreign language provisional application has been received.

15)  Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO-1449) Paper No(s) 1/2  
4)  Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_  
5)  Notice of Informal Patent Application (PTO-152)  
6)  Other: \_\_\_\_\_

***Priority***

1. The continuing data filed with the case is inconsistent with PTO records. It appears that that the application number from which this application is continued have been transposed, 09/453,883 rather than 09/435,883 and the resulting patent should be 6,199,753.

Appropriate correction is required.

***Information Disclosure Statement***

2. IDS submitted with the application has been considered.

***Claim Objections***

3. The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered claims 31-32 been renumbered 29-30.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 23-24, 27-28 are rejected under 35 U.S.C. 102(b) as being anticipated by Bianco (5,407,614).

As per Claim 23.

Bianco ('614) discloses:

- a) generating a list of desired items at a location remote from a shopping facility, see column 2, lines 8-16;
- b) storing said list in a user data file on a first computer, see column 2, lines 13-16;
- c) retrieving the list at the shopping facility from the user data file using a kiosk which communicates with the first computer, see column 2, lines 16-17; and
- d) delivering the list to the user at the shopping facility in a user perceptible format, see column 2, line 17 and figure 2.

As per Claim 24.

Bianco ('614) further discloses the first computer which is used to generate the list is a user computer located outside the shopping facility, see column 2, lines 11-13, and said list is communicated to said kiosk through an electronic communication means, see column 2, lines 19-21.

As per Claim 27.

Bianco ('614) further discloses delivering marketing messages to the user on the list delivered in user perceptible format, see column 4, lines 1-8 and lines 49-68.

As per Claim 28.

Bianco ('614) further discloses delivering marketing messages are selected from the group comprising a discount coupon and competitive product availability, see column 4, lines 1-8 and lines 49-68.

#### ***Claim Rejections - 35 USC § 103***

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 25, 29 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bianco (5,047,614) in view of Roach et al (5,310,997).

As per Claim 25.

Bianco ('614) does not specifically disclose that step (c) comprises delivering a message to the user identifying items that are out of stock.

Roach et al ('997) teaches a determination of whether an item is in stock and suggested alternative products, see column 12, lines 17-25 for the benefit of making a sale even though the desired item is not available.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to modify the invention of Bianco ('614) to make a determination at the time of download at the kiosk to check inventory and provide a message regarding the availability and suggest alternatives, as taught by Roach et al ('997) for the benefit of making a sale even though the desired item is not available.

As per Claim 29.

Bianco ('614) discloses:

at least one kiosk for generating a customer list of items to be purchased by a plurality of customers, see column 2, lines 8-21 and figure 2;

Bianco ('614) does not specifically disclose:

a self-scanning system for permitting each of the plurality for customers to select items using a portable shopping terminal to maintain an updated list of selected items, and

a plurality of checkout lanes for tendering payment of the items selected for purchase by the customer.

Roach et al ('997) teaches:

a self-scanning system for permitting each of the plurality for customers to select items using a portable shopping terminal to maintain an updated list of selected items, see column 11, line 56 – column 12, line 3, and

a plurality of checkout lanes for tendering payment of the items selected for purchase by the customer, see figure 2 (234, 15) for the benefit of increased convenience and speed of shopping for the customer.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to modify the invention of Bianco ('614) to provide a

self-scanning system and a plurality of checkouts for the benefit of increased convenience and speed of shopping for the customer.

***Allowable Subject Matter***

7. Claim 30 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

As per Claim 30.

Bianco ('614) does not specifically disclose a shopping list distribution communication device for delivering the customer list presented on the kiosk to the portable terminal corresponding to the customer using the self-scanning system.

***Prior Art Made of Record***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Martinez (GB 2 276 258) is the closest foreign art and teaches an ordering system but does not disclose all the limitations of the claims.

NFR Highlights Future Tech is the closest non-patent art and teaches kiosk ordering/payment and separate pickup, but does not teach all the limitations of the claims.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas A. Dixon whose telephone number is (703) 305-4645. The examiner can normally be reached on Monday - Thursday 6:30 - 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (703) 308-2702. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7687 for regular communications and (703) 305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.



Thomas A. Dixon  
Examiner  
Art Unit 3629

September 3, 2002